

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID P. KIELPIKOWSKI

Appeal No. 1997-4264
Application No. 08/421,131¹

ON BRIEF

Before ABRAMS, STAAB and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 24, which are all of the claims

¹Application for patent filed April 13, 1995. According to appellant, this application is a continuation of Application No. 08/160,521, filed December 1, 1993, now abandoned.

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pending in this application.

We AFFIRM-IN-PART.

The appellant's invention relates to an absorbent article, such as, a disposable diaper, having a pair of containment flaps (10) to improve the lateral containment of body exudates. Specifically, appellant's containment flaps include a barrier layer (20) which is stitched with from 1 to 10 elastomeric threads (22) (specification, pages 7 and 8). Appellant's claims are directed to a containment flap (claims 1 through 10 and 21 through 24), to an absorbent article including a pair of containment flaps (claims 11 through 16) and to a method of making an absorbent article including the steps of providing a pair of barrier layers and stitching each barrier layer with at least one elastomeric thread to form a pair of containment flaps (claims 17 through 20). A more complete understanding of the invention can be derived from a reading of exemplary claims 1, 11 and 17, which appear in the appendix to appellant's "Response" filed May 27, 1998 (Paper No. 15).

The prior art references of record relied upon by the

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examiner in rejecting the appealed claims are:

Burger 1972	3,663,962	May 23,
Van Vliet 1981	4,297,157	Oct. 27,
Greene 1987	4,674,135	Jun. 23,
Lawson 1987	4,695,278	Sep. 22,
Zafiroglu 1988 (Zafiroglu '238)	4,773,238	Sep. 27,
Zafiroglu 1989 (Zafiroglu '169)	4,879,169	Nov. 07,
Zafiroglu 12, 1991 (Zafiroglu '421)	4,998,421	Mar.

As a preliminary matter, we note that on pages 2 and 3 of the Office action mailed April 4, 1996 (Paper No. 15), the specification was objected to under 35 U.S.C. § 112, first paragraph, as failing to support the invention being claimed and claims 1 through 16 and 21 through 24 were rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification. In the next Office action (Paper No. 17), which was made final, the examiner again objected to the specification, but omitted the rejection of

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claims 1 through 16 and 21 through 24 based on 35 U.S.C. § 112, first paragraph. In the brief (Paper No. 21), at page 3, appellant identifies the first issue presented for our review as "[w]hether the specification contains a written description of the invention in such full, clear, concise, and exact terms to enable a person skilled in the art to make and use the same under 35 U.S.C.

§ 112, first paragraph?" Appellant's brief also contains an argument (pages 4 and 5) that the examiner's objection to the specification should be reversed. In the answer (pages 3 and 4), the examiner identifies the first issue in this appeal as including both an objection to the specification, directing our

attention to page 2 of the final rejection, and a rejection of claims 1 through 24 under 35 U.S.C. § 112, first paragraph, "for the reasons set forth in the objection to the specification." The rejection of claims 1 through 24 under 35 U.S.C. § 112, first paragraph, was not identified as a new ground of rejection in the answer. The appellant has not raised any objection to the examiner's inclusion of the § 112,

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first paragraph, rejection of claims 1 through 24 in the answer. According, the following rejections are before us for review:

(1) Claims 1 through 24 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking support in the original disclosure.

(2) Claims 1 through 4 and 6 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lawson in view of Van Vliet, Burger, Zafiroglu '169 and Zafiroglu '421.

(3) Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Lawson, Van Vliet, Burger, Zafiroglu '169 and Zafiroglu '421, as applied to claim 1 and further in view of Zafiroglu '238.

(4) Claims 1 and 21 through 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Greene.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Office action mailed December 14, 1994 (Paper No. 8), to the final rejection (Paper

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No. 17) and to the answer (Paper No. 22) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 21) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. The determinations we have made and the reasons behind them are set forth below.

Rejection (1)

According to the answer (page 4), the examiner's reasoning for the rejection of claims 1 through 24 under 35 U.S.C. § 112, first paragraph, can be found on page 2 of the final rejection (Paper No. 17).

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan

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that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the appellant's disclosure a description of the invention defined by the claims. See In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976); Ex parte Sorenson, 3 USPQ2d 1462, 1463 (Bd. Pat. App. & Inter. 1987). This the examiner has not done. In any event, it is our opinion that the language of claims 1 and 11 in dispute (i.e., "said distal edge of said containment flap is rendered elastically contractible by said at least one elastomeric thread to position said distal edge in said spaced relation") is described in the original disclosure for the reasons set forth on pages 4 and 5 of the appellant's brief. The examiner has not identified any language in claims 17 through 20 that is unsupported by the original disclosure.

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Accordingly, we will not sustain the standing 35 U.S.C.
§ 112, first paragraph, rejection of claims 1 through 24.

Rejection (2)

We begin with the examiner's rejection of independent claims 1, 11 and 17. Claim 1 calls for a containment flap comprising, inter alia, at least one elastomeric thread and a barrier layer which is stitched with said at least one elastomeric thread adjacent an edge of the containment flap wherein said edge is rendered elastically contractible by said at least one elastomeric thread. Claim 11 contains the same language in combination with absorbent article structure. Claim 17 sets forth a method of making an absorbent article including the steps of providing a pair of barrier layers and stitching each barrier layer with at least one elastomeric thread to form a pair of containment flaps.

The examiner describes Lawson as teaching all the claimed subject matter, except for the barrier layer being stitched by an elastomeric thread. Van Vliet, Burger and Zafiroglu '169

are cited by the examiner to show that it was well known at the time of appellant's invention to substitute sewing for adhesive, thermal or ultrasonic bonding. Zafiroglu '421 is described by the examiner as teaching "economically providing stretchability in elasticated [sic] portions of diapers, cuffs, etc. by stitching with elastic threads" (Paper No. 8, page 3). The examiner concludes that in view of the teachings of Van Vliet, Burger and Zafiroglu '169, it would have been obvious to use stitching to secure Lawson's elastic spacing members (77) to the distal edge of the barrier cuff instead of adhesive as taught by Lawson and, in view of Zafiroglu '421, it would have been obvious to use elastic thread for the stitching (id.).

The appellant points out that Van Vliet, Burger and Zafiroglu '169 teach stitch-bonding an elastic material to a substrate material with conventional thread at selected portions along the elastic material and that Zafiroglu '421 teaches a process for making stitch-bonded elastic fabrics and

an elastic fabric made by the process for use in elasticized portions of diapers, cuffs, waistbands, bandages, and the like (brief, page 7). Appellant argues, inter alia, that the applied prior art teaches, at best, using the stitch-bonded elastic fabric taught by Zafiroglu '421 as the elastic spacing members (77) in Lawson and using adhesive, sonic bonding, thermal bonding or conventional (i.e., non-elastic) thread to secure the stitch-bonded elastic fabric taught by Zafiroglu '421 to the distal ends of Lawson's barrier cuffs. Thus, in appellant's view, the prior art fails to teach or suggest a containment flap having a distal

end or unattached edge which is stitched with an elastomeric thread to render the flap contractible or gatherable (id. at 8).

Based on our review of Zafiroglu '421, we find that the reference teaches using an elastic stitch-bonded fabric as the elasticized portion of a diaper, cuff, waistband, bandage, and

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the like. Zafiroglu '421 does not suggest using elastomeric thread for bonding elastic stitch-bonded fabric to another material. Thus, we agree with appellant that the combined teachings of Van Vliet, Burger, Zafiroglu '169 and Zafiroglu '421 would not have suggested using an elastomeric thread to stitch the elastic strands (77) taught by Lawson to the distal ends of Lawson's barrier cuffs.

In view of the above, we will not sustain the standing 35 U.S.C. § 103 rejection of independent claims 1, 11 and 17 based on Lawson, Van Vliet, Burger, Zafiroglu '169 and Zafiroglu '421.

For the same reasons, the rejection of claims 2 through 4, 6 through 10 and 21 through 24, dependent on claim 1, the rejection of claims 12 through 16, dependent on claim 11, and the rejection of claims 18 through 20, dependent on claim 17, will not be sustained.

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Rejection (3)

We have also carefully reviewed the Zafiroglu '238 reference additionally relied upon by the examiner in support of the rejection of claim 5, but find nothing therein that makes up for the deficiencies of Lawson, Van Vliet, Burger, Zafiroglu '169 and Zafiroglu '421 noted above. It follows that the standing § 103 rejection of claim 5, dependent on claim 1, as being unpatentable over Lawson, Van Vliet, Burger, Zafiroglu '169, Zafiroglu '421 and Zafiroglu '238 cannot be sustained.

Rejection (4)

With respect to this ground of rejection, appellant has indicated that claims 1 and 21 through 24 stand or fall together (brief, page 4). Accordingly, we select independent claim 1 for review. As to claims 21 through 24, they will stand or fall with selected claim 1. 37 CFR § 1.193(c)(7).

Appellant argues that the disposable undergarment described in Greene is not an absorbent article and that Greene neither teaches nor suggests the use of an elastomeric thread to

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maintain an edge of a containment flap in an upright, spaced away position as recited in claim 1 (brief, pages 11-13).

However, we must point out that the recitations that the containment flap is "for use on an absorbent article," that the proximal edge is "adapted

to be joined to said absorbent article," and that the distal edge is "configured to position itself in a spaced relation away from a bodyside liner of said absorbent article" are merely statements of intended use. The particular manner in which a device or article is used, however, cannot be relied on to distinguish structure from the prior art. See, e.g., In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). Here, the only structure of the "containment flap" recited in claim 1 is that the "containment flap" has a length and opposite edges and comprises an elastomeric thread and a "barrier layer" which is stitched with the elastomeric thread adjacent one edge. Appellant's specification explains that as a result of

stitching

the distal edge with the elastomeric thread, the "flap 10 tends to contract or gather and position itself in a spaced relation

away from the bodyside liner 40 toward a generally upright and approximately perpendicular configuration" (page 12).

Obviously, the material taught by Greene also has a length (see Figure 2) and opposite edges, such as the opposite edges shown in Figure 2 which eventually form the waist portion (24). At least one of

Greene's opposite edges is stitched with an elastomeric thread adjacent the edge. The fabric taught by Greene is capable of being used as a containment flap and whether Greene's material actually is, or might be, used in such a manner depends upon the performance or nonperformance of a future act of use, rather than a structural distinction in the claims.²

² Along the same line, we note that: [1] appellant's specification describes spunbond polypropylene as a suitable material for the barrier layer (page 6) and spandex elastomeric thread, e.g., Lycra® thread, as a suitable material for the "at least one elastomeric thread" (page 8) and [2] Zafiroglu

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Thus, as argued, we will sustain the standing § 103 rejection of claim 1. It follows that we will also sustain the standing § 103 rejection of claims 21 through 24, since they stand or fall with selected claim 1.

CONCLUSION

In summary, this panel of the board has:

reversed the rejection of claims 1 through 24 under 35 U.S.C. § 112, first paragraph;

reversed the rejection of claims 1 through 4 and 6 through 20 under 35 U.S.C. § 103 as being unpatentable over Lawson, Van Vliet, Burger, Zafiroglu '169 and Zafiroglu '421;

reversed the rejection of claim 5 under 35 U.S.C. § 103 as being unpatentable over Lawson, Van Vliet, Burger,

'421 teaches an elastic stitch bonded fabric having a length and opposite edges comprising a nonwoven material, e.g., spunbonded polypropylene (col. 3, line 20), stitched with at least one spandex elastomeric yarn, e.g., Lycra® (col. 4, line 2) adjacent its edges. Thus, it would appear that the material taught by Zafiroglu '421 is also capable of being used as a containment flap. Upon the resumption of prosecution, the examiner and the appellant may wish to refocus on the teachings of Zafiroglu '421 and determine whether any differences actually exist between the structure recited in claim 1 and its dependent claims and the teachings of Zafiroglu '421, keeping in mind that a new intended use for an old product does not make a claim to that old product patentable. In re Schreiber, supra.

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Zafiroglu '169, Zafiroglu '421 and Zafiroglu '238;

affirmed the rejection of claims 1 and 21 through 24
under 35 U.S.C. § 103 as being unpatentable over Greene.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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